REMARKS / ARGUMENTS

Reconsideration of the present application is respectfully requested. Claims 1, 2, 6, 21, 41, 44 and 45 are pending.

Claims 2 and 40 are cancelled without prejudice. Applicants retain the right to pursue the subject matter of the cancelled claims in continuation or divisional applications.

Claims 1, 6, and 21 have been amended. No new matter has been added by way of the amendments. Support for the amendments to the claims can be found in the original claims and throughout the specification.

The specification has been amended on page 4, beginning at line 22, to correct a typographical error in reciting the number of nucleotides in SEQ ID NO:1. The amendment is supported by the Sequence Listing as originally filed which lists SEQ ID NO:1 as having 1,147 nucleotides as reflected in the amended paragraph.

Reexamination and reconsideration of the application as amended are respectfully requested.

Rejections under 35 U.S.C. §112

Rejections under 35 USC §112, first paragraph

Written Description

Claims 1, 2, 6, 21, 40 and 44-45 are rejected under 35 USC §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Office Action states: "The claims are drawn to an isolated promoter comprising a nucleotide sequence natively associated with and that drives

expression of DNA coding for the maize Jip1 (jasmonate induced protein-1), a nucleotide sequence set forth in SEQ ID NO:1 or a nucleotide sequence comprising a fragment of the nucleotide sequence set forth in SEQ ID NO:1, or an expression cassette comprising said promoter.... Applicants do not describe any promoter fragments of SEQ ID NO:1 nor do Applicants identify essential regions of the promoter sequence natively associated with the Jip1 coding sequence.... Amending claim 6 to recite 'the nucleotide sequence set forth in SEQ ID NO:1' will obviate this rejection for claim 6".

Claims 2 and 40 have been cancelled without prejudice. Claim 6 has been amended according to the Examiner's suggestion. Claim 21 has been amended to recite: "... wherein the promoter comprises the nucleotide sequence set forth in SEQ ID NO:1; and a sequence comprising a fragment of the nucleotide sequence set forth in SEQ ID NO:1."

Supporting arguments previously submitted in the amendments filed August 8, 2003 and April 19, 2004 are maintained. Functional cis-acting elements responsible for seed-preferred were well known in the art at the time of filing. Further, by disclosing identifying characteristics such as transcription initiation sites and expression pattern as determined by Northern blot, one of skill in the art would reasonably conclude that the applicant was in possession of the claimed invention. Accordingly, this rejection should be withdrawn.

Scope of Enablement

Claims 1, 2, 6, 21, 40, 41 and 44-45 are rejected under 35 U.S.C. §112, first paragraph because the specification fails to describe the subject matter of the rejected claims in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Office Action states: "Applicants have not shown that the isolated promoter sequence consisting of the 1241 base pairs set forth in SEQ ID NO:1 does

in fact replicate the expression profile as disclosed from the Northern analysis (page 30-31, Example 6).

Applicants assert it was readily accepted in the art at the time of filing that the expression profile of a coding region as determined by Northern analysis is positively correlated with the expression pattern of the isolated promoter. The Office has provided no reasoning or evidence that the predictive Northern analysis is unreliable or insufficient.

> "...Only after the PTO provides evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince such a person of the invention's asserted utility." *In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971).

The Office Action further states : "In addition, Applicants have not disclosed why SEQ ID NO:1 is 1247 base pairs in length and the Jip1 promoter is disclosed as consisting of 1241 base pairs (See page 4, line 22)."

The specification has been amended to correct a typographical error in the paragraph on page 4, beginning on line 22 which recited the number of nucleotides in SEQ ID NO:1 as 1241. The correct and amended paragraph now recites the number of nucleotides as 1247 as supported by the Sequence Listing as originally filed.

The Office Action further asserts: "The claims are broadly drawn to a fragment of SEQ ID NO:1 however, the instant specification, fails to provide guidance for which base of SEQ ID NO:1 can be altered and still maintain proper spatial and temporal seed-preferred expression. The specification also fails to provide guidance for which base can be deleted and which regions of the sequence can tolerate additions, base-substitutions or recombinations and still function as the full length promoter."

The rejection is respectfully traversed. Supporting arguments previously submitted in the amendments filed August 8, 2003 and April 19, 2004 are maintained.

The screening of panels or libraries containing from a few, to many, inoperative species in order to isolate one or more operative species is a common practice in many aspects of the biotechnological arts. And as the *Wands* court makes clear, this type of experimentation cannot be considered undue, but rather is merely routine experimentation. Thus, it logically follows that the isolation of operative Jip1 promoter fragments from a panel or library of candidate promoter fragments is not undue experimentation where the Examiner has not put forth any evidence that the number of inoperative species would be significant, where temporal and spatial expression motifs are known in the art, and where one skilled in the art clearly has a reasonable expectation of success in achieving functional maize Jip1 promoter fragments that are commensurate in scope with the present claims. Accordingly, this rejection should be withdrawn.

CONCLUSION

On the basis of the above remarks and amendments, reconsideration of the application and its allowance are respectfully requested.

Respectfully submitted,

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